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10/511,797	10/19/2004	Toni Kopra	KOLS.155US	4278

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EXAMINER
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RUSTEMEYER, BRETT J

ART UNIT	PAPER NUMBER
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2426

MAIL DATE	DELIVERY MODE
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02/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,797	<b>Applicant(s)</b> KOPRA ET AL.	
	<b>Examiner</b> BRETT RUSTEMEYER	<b>Art Unit</b> 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01/02/2009 (Applicant's Response).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Continued Examination under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 2<sup>nd</sup>, 2009 has been entered.

### ***Art Unit Change***

2. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2426.

### ***Response to Amendment***

3. This Office action is in reply to Applicant's amendment and response dated January 2<sup>nd</sup>, 2009, hereinafter "Applicant's Response". In response to the rejections made in a previous Office action issued by the Examiner, dated September 3<sup>rd</sup>, 2008, hereinafter "Examiner's Action", the Applicant amended claims 1, 11, and 21. Further, the Applicant respectfully requested the withdrawal of the Examiner's 35 U.S.C. § 102(e) & § 103(a) rejections pertaining to claims 1-25, in light of the amendments and remarks provided. Claims 1-25 are pending.

***Response to Arguments***

4. Applicant's arguments, documented in Applicant's Response, with respect to the rejection of claims 1-4, 6-10, 21, 22, 24, and 25 under 35 U.S.C. § 102 (e) and 5, 11-20, and 23, have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

5. Claims 4, 6, 7, 14, 16, 17, 22, 24, and 25 are objected to because of the following informalities: "the radio system" should be amended to "the mobile radio system" for consistency with the amendments made to their respective independent claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

a. Regarding claims 10 and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

8. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication Number “2006/0288374 A1” to Ferris et al., hereinafter “Ferris”, in view of United States Patent Publication Number “2004/0014454 A1” to Burgess et al., hereinafter “Burgess”.

**Regarding claim 1**, Ferris is directed to the display of advertisements, product and service offers, and other information (collectively, “display data”) provided to a user of a radio receiver for further interaction (*Ferris*, Fig. 3, Abstract). According to one embodiment, broadcasters 402 disseminate content to broadcast receivers 405 in users’ homes 416 (*Ferris*, [0048]). The transmission mechanism may involve terrestrial radio-frequency broadcast, satellite radio-frequency broadcast, wired, or fiber optic cable transmission (*Ferris*, [0048]). “A rolling ‘playlist’ is compiled for each broadcast channel, containing the program associated data (PAD)

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display data records and their respective cue points. This information is fed, whether well or only very shortly in advance of the earliest cue point in the segment of the rolling list passed at that time, to a PAD scheduler 411 at a central processing station 420. Such a list may be provided by any combination of the sponsors 401, the broadcasters 402, or by some third party 406 which annotates programmes, either as these programmes are broadcast or ahead of time” (*Ferris*, [0049]).

A matching engine at the central processing station continuously compares input from the various broadcast channels with multimedia samples, and uses a commonly known algorithm to determine when a ‘match’ has occurred (*Ferris*, [0050]). “When the next display message is due to be transmitted, as may be detected at the PAD scheduler 41 using either a polling or, preferably, an interrupt mechanism, it is retrieved from a PAD database 408, given a unique identification number (PADUID), and sent to a transmission gateway 413, which may be physically remote, where it is translated into the correct format to be sent over a radio transmission service 414” (*Ferris*, [0052]). Preferred embodiments include: using the text message transmission protocols of a cellular network of paging transmitters; transmitting data using a radio sub carrier scheme; and utilizing the data transport mechanisms of the Digital Audio Broadcasting (DAB) system for transmitting information to the device (*Ferris*, [0052]-[0055]). The device 417 will display the incoming PAD display data to the user at the appropriate cue point, and may accept interaction from the user on the basis of the information so displayed.

Details of such interaction, where relevant, may be transmitted back central control station 420 together with the unique handset/user id (HUID) and PADUID of the initial display

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data (*Ferris*, [0056]) via a Radio Service Provider 415 (which may or may not be the same as provider 414) - (*Ferris*, [0057]). Preferred return channels include: performing encoding and transmission by a two-way paging chipset; making use of bandwidth available within a digital cellular telephony system under some protocol (e.g., SMS of a GSM network); and sending signals over an unlicensed radio data network (e.g., metropolitan packet-relay system) - (*Ferris*, [0056]-[0057]). The user may interact with the PAD display data through the receiving apparatus to initiate a purchase sequence by pressing the 'BUY NOW!' button 9 (*Ferris*, FIGS. 1, 2A, 4, [0095]). "If the user opts to buy, then the screen of FIG. 2C is shown, which contains a request to confirm the transaction 114, a selection of credit and/or debit cards 113 to choose from (chosen by pressing one of the side variable function buttons, 15 on FIG. 1), and the option to cancel the transaction 117. Selecting a credit card will bring up a 'successful order' screen, not shown here" (*Ferris*, FIG. 2C, [0096]). As the user's name and address is held in the user database 410, the process of purchasing, or requesting the mail-out information, is greatly simplified (*Ferris*, [0062]).

Therefore, *Ferris* reads on the claimed:

*a method of delivering an object relating to a broadcast media stream to a user terminal of a mobile radio system, the method comprising:*

*broadcasting the media stream (i.e., content) by a broadcast system (e.g., broadcasters 402),*

*associating the object (e.g., advertised product or service) to the media stream (i.e., content) in the broadcast system (The advertised product or service represented by the PAD display data is "associated" to the content through the playlist),*

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*delivering an object identification (e.g., PAD display data) of the object wirelessly (e.g., via Radio Service Provider 414) from (i.e., provided by) the broadcast system to at least one user terminal (e.g., receiving apparatus 417),*

*presenting (e.g., displaying) the object identification (e.g., PAD display data) in synchronization (i.e., at the respective cue points) with the media stream (i.e., content) in the user terminal (The PAD display data is displayed at the respective cue point in the broadcast content by the receiving apparatus), and*

*sending (e.g., via the return channel), if a user requests the delivery of the object (e.g., advertised product or service) based on the object identification (e.g., PAD display data), a transaction signal (e.g., purchase request) with the object identification (e.g., PADUID; wherein PADUID is a portion of the PAD display data) from the user terminal (e.g., receiving apparatus 417) to a database (e.g., at the Central Processing Station) through the radio system (e.g., Radio Service Provider 415).*

Ferris is silent with respect to:

*sending ... a transaction signal ... from the user terminal to a database of at least one object, and*

*delivering the object of the object identification from the database to the user terminal, which sent the request signal, through the radio mobile system.*

In analogous art related to problems associated with the enablement of a user request for advertised products and services through a radio network, Burgess provides evidence regarding processing and fulfillment of a user's request. In particular, the reference teaches of transmitting a user request message from a cellular tower 14 to a mobile switching center (MSC) 16 (*Burgess*,



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[0019]). The MSC 16 analyzes the message and transmits the message to the appropriate SCP (Service Control Point) system 20 (*Burgess*, [0019]-[0020]). The SCP may utilize an Advertisement Code Database 24 to associate data codes within the request message with specific product information, such as advertiser provided content (*Burgess*, [0022]). “In the event that the SCP 20 determines that there is product information associated with the data code in the dialed digits string, then the SCP 20 send the product information to the user that dialed the call through the content delivery system (CDS) 25 using a delivery technique indicated by the information in the user account associated with ... the request message” (*Burgess*, [0022]). According to one embodiment, “the delivery technique may be SMS (Short Message Service), in which case the product information stored in the Advertiser Code Database consists of a text message to be delivered back to the mobile phone on which the original call was place using the SMS protocol. Other examples of delivery techniques that may be used are WAP (Wireless Application Protocol) push, or a MMS (Multi-media Messaging Service) message, or an EMS (Enhanced Messaging Service) message”, etc (*Burgess*, [0022]).

Thus, it would have been obvious to one ordinarily skilled in the art, at the time of the invention, to apply to the technique of purchasing and delivering an advertised product or service as disclosed by Burgess to respectively improve the capabilities and necessary components of the Central Processing Station 420, Radio Service Providers 414-415, and receiving apparatus 417 of Ferris for the predictable result of providing a means for associating a user request with the requested product or service and delivering the user requested product or service to the user's receiving apparatus.

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Therefore, the combined teaching of Ferris and Burgess, as a whole, reads on:

sending (e.g., via a return channel) ... a transaction signal (e.g., purchase request)... from the user terminal (e.g., modified receiving apparatus 417) to a *database* (e.g., PAD database 408/Advertiser Code Database 24, or Vendor Database 409/CDS 25) *of at least one object* (e.g., advertised product or service/Advertiser's Content), *and*

*delivering the object* (e.g., advertised product or service/Advertiser's Content) *of the object identification* (i.e., PAD display data) *from the database* (e.g., at the modified Central Processing Station-including capabilities of the Advertiser Code Database and CDS 25) *to the user terminal* (e.g., modified receiving apparatus 417), *which sent the request signal, through the radio mobile system* (e.g., modified Radio Service Provider Network 414-415).

**Regarding claim 2**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising providing {(e.g., by a sponsor 401) - (Ferris, [0048])} the broadcast system* (i.e., broadcaster 402) *with object identifications* (e.g., PAD display data) *of the objects* (e.g., advertised product or service/Advertiser's Content) *available in a database of an object provider* (e.g., modified Central Processing Station).

**Regarding claim 3**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising creating* (arranging for transmission of information over the service 414) *the objects* (e.g., advertised product or service/Advertiser's Content) *and the object identifications* (e.g., PAD display data) *in the broadcast system and*

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*saving the objects in a database (e.g., PAD Database 411/Advertiser Code Database) in accordance with the embodiment of Ferris as disclosed in [0052] in conjunction with [0022].*

**Regarding claim 4**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising delivering the object identification from the broadcast system to at least one user terminal through the radio system* in accordance with the embodiment of Ferris wherein the broadcaster provides the 'play list' containing the PAD display data records and their respective cue points to the Central Processing Station as discussed in [0049].

**Regarding claim 5**, the combined teaching of Ferris and Burgess, as a whole, discloses *the method of claim 1, the method further comprising delivering the object identification from the broadcast system to at least one user terminal as an RDS broadcast*, in accordance with the embodiment of Ferris (*Ferris*, [0055]) wherein the Digital Audio Broadcasting (DAB) system are used to transmit information to the device (as defined in ETS 300 401 - "Radio Broadcasting Systems; Digital Audio Broadcasting (DAB) to Mobile, Portable and Fixed Receivers" - See {Page 11, Section 2, [5]}, {Page 18, Section 3.2, Line 39}, {Page 50, Section 6.3.1, **Country Id** and **ECC**} and {Page 100, Section 8.1.4, **PNum**} of ETS 300 401, May 1997, Second Edition).

**Regarding claim 6**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising sending the transaction signal from the user terminal directly to the database of the object provider through the radio system* in accordance

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with the embodiment of Burgess wherein the user request message is sent through a cellular tower 14 (i.e., BTS) and mobile switching center (MSC) 16 (*Burgess*, [0019]) to the SCP containing a plurality of databases (e.g., PAD database 408/Advertiser Code Database 24, or Vendor Database 409/CDS 25). In this interpretation, the radio system comprises the BTS and MSC; and the Central Processing Station comprises the capabilities and necessary components of the SCP. Thus, the message is sent *directly to the database of the object provider*.

**Regarding claim 7**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising sending first the transaction signal from the user terminal to a server (e.g., Interaction Processor 407/SCP 20) serving the broadcast system (i.e., broadcaster 402) through the radio system (Ferris, FIG. 3[0060]), and sending a signal with the object identification (e.g., PADUID; wherein PADUID is a portion of the PAD display data) from the server to the database (e.g., PAD database 408/Advertiser Code Database 24, or Vendor Database 409/CDS 25) of the object provider (e.g., at the modified Central Processing Station-including capabilities of the Advertiser Code Database 24 and CDS 25).*

**Regarding claim 8**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising associating the object identification to the media stream (e.g., at a respective cue point) such that the object identification (e.g., PAD display data) is attached to a broadcasting timeline (e.g., via the 'play list') of the media stream, and delivering (i.e., displaying) the object identification (e.g., PAD display data) in accordance*

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*with the broadcasting timeline (e.g., via the 'play list') of the media stream {(i.e., content) (Ferris, [0049], [0056])}.*

**Regarding claim 9**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising recording and processing the transfer of each object to the user terminals by means of a transaction processing device* in accordance with the embodiment of Ferris wherein the interaction processor, analogous to the SCP of Burgess, utilizes the user database 410 to store users' transaction histories and both the PAD database 408 and Vendor Database 409 to process users' request as discussed in (Ferris, [0060]-[0061]).

**Regarding claim 10**, the combined teaching of Ferris and Burgess, as a whole, reads on *the method of claim 1, the method further comprising identifying the format (e.g., cue point, legitimacy) of the object identification (e.g., PAD display data) and the object (e.g., advertised product or service/Advertiser's Content - SMS message) by means of the user terminal (e.g., modified receiving apparatus 417), the identifying revealing information, such as the supporting application needed, additional rights pertaining to the object, forwarding limitations associated with the object, or any combination thereof* (Ferris, [0067], [0073]).

**Regarding claim 11**, the combined teaching of Ferris and Burgess, as a whole, reads on the respective limitations of claim 1, in addition to:

*... the media system further comprising:*

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*a radio system including at least one base station {(i.e., cellular tower, or BTS) – (Burgess, [0019])} ... the broadcast system having a connection to the radio system (Ferris, FIG. 3, Broadcasters 402 connected to PAD Scheduler 411 for transmitting 'play list', [0049]),*

*the broadcast system (i.e., broadcasters 402) being configured to associate (e.g., at a respective cue point) at least one object identification (e.g., PAD display data) to a broadcasting timeline (e.g., via the 'play list') of the broadcast media stream (i.e., content).*

**Regarding claims 12-20**, please refer to the citations and remarks stated by the Examiner in response to claims 2-10, respectively.

**Regarding claim 21**, please refer to the citations and remarks stated by the Examiner in response to claim 1.

**Regarding claims 22-25**, please refer to the citations and remarks stated by the Examiner in response to claims 4-7, respectively.

### ***Contact***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brett Rustemeyer whose telephone number is (571) 270-1849. The examiner can normally be reached on Mon. - Thurs. 6:30 a.m.-5 p.m. EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava

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can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BR/

Examiner - Art Unit 2426

February 9<sup>th</sup>, 2009

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2426